

Remarks

The present Amendment is being filed together with a "Request for Continued Examination (RCE) Transmittal", as a submission pursuant to 37 C.F.R. §1.114(c). Reconsideration of this Patent Application is respectfully requested.

The Office Action mailed April 28, 2009, first acknowledges consideration of the Information Disclosure Statement which was filed on January 12, 2009, and the undersigned thanks the Examiner for this acknowledgement.

The Office Action of April 28, 2009, next objects to the substitute specification which was submitted with the Reply of January 12, 2009, under 35 U.S.C. §132(a), because submitted amendments are alleged to have introduced what has been characterized as "new matter" into the disclosure. This position is respectfully traversed in view of the discussion which follows.

The added material which is not considered to be disclosed by the original specification is identified at page 2 of the Office Action, and is said to include subject matter contained in a sentence beginning at line 23 of page 3 (i.e., "The screw thread 17 is interrupted at regular intervals... the thimble support 4"). However, lines 16 and 17 of page 3 of the original disclosure specifically state that the "screw thread 17 is interrupted at regular intervals" and corresponding structure

was shown in originally submitted Figures 1 and 2.

Also identified at page 2 of the Office Action is subject matter which is said to be found "on page 5, lines 16 and 17". No specific language has been identified, making it unclear whether the language being objected to relates to the previously identified "screw thread... interrupted at regular intervals" or some other language presented in the substitute specification. However, if this is referring to the previously discussed "screw thread... interrupted at regular intervals", then support for this language can be found at lines 16 and 17 of page 3 of the original disclosure and in originally submitted Figures 1 and 2. If this is referring to the disclosure that an "annulus 2 can further be provided which has a purely decorative function, and can be ornamented in various ways", then support for this language can be found at lines 24 and 25 of page 3 of the original disclosure, which specifically states that the "annulus 2 has a purely decorative function. It may be ornamented in various ways."

In any event, appropriate support for the language presented in the sentence beginning at line 23 of page 3 of the substitute specification, and on page 5, at lines 16 and 17, is found in the originally submitted specification and drawings, and reconsideration and withdrawal of the objection to the substitute specification which was submitted with the Reply of January 12, 2009, under 35 U.S.C. §132(a), is respectfully requested.

Although not required to establish proper support for the subject matter disclosed in the sentence beginning at line 23 of page 3 of the substitute specification, a "Replacement Sheet" of drawings is submitted with this Amendment which includes the reference number 27 to correlate the interruptions in the screw threads 17 shown in the drawings with the description presented in the sentence beginning at line 23 of page 3 of the substitute specification, and the corresponding paragraph has been amended to include the reference number 27. Entry of this Replacement Sheet of drawings is respectfully requested.

The Office Action of April 28, 2009, next rejects claims 22 and 31 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. This rejection is also respectfully traversed in view of the discussion which follows.

Claim 22, which has currently been replaced with a corresponding claim 38, recites an "external screw thread... interrupted at regular intervals". As previously indicated, such structure was fully described at lines 16 and 17 of page 3 of the original disclosure, and was correspondingly illustrated in originally submitted Figures 1 and 2.

Claim 31, which has currently been replaced with a corresponding claim 33, recites "the position of the adjustment stop is variable". Such structure was fully described in the original disclosure, for example, from line 14 of page 2 to line

13 of page 3, and was correspondingly illustrated in originally submitted Figures 1 and 2. Lines 14 to 17 of page 2 indicated that:

The top part of the device 1 according to the invention consists of an adjustment ring 3 which is operated by turning it. The top of this adjustment ring 3 is provided with an adjustment stop 5 with an indexing bar 12. (emphasis added)

Lines 18 to 22 of page 2 then indicated that:

This indexing bar 12 can be used to set the grinding to certain well-defined sizes. However, the grinder can also be adjusted sensitively, that is all the way around the adjustment ring and not only in the notches provided for this purpose. (emphasis added)

Lines 9 to 13 of page 3 then indicated that:

The thimble support 4 also possesses five notches 16 designed to take the indexing bar 12. It therefore offers five indexed positions, but the intermediate positions are still possible, so there is a great variety of size of grind. (emphasis added)

Also to be noted are lines 20 to 24 of page 4, stating that:

Turning the adjustment ring 3 therefore results in a vertical movement of the thimble support 4.

This movement will be limited both by the stop 5 and by the reinforcement 15. It may have a maximum amplitude of 3 mm, thus varying the fineness of the grind. (emphasis added)

Also disclosed and illustrated are the cooperating screw threads 14, 17 which serve to enable such operation.

Consequently, language corresponding to the recited elements of rejected claims 22 and 31 (now claims 38 and 33,

respectively) can be found in the specification originally submitted for this Patent Application, and implemented embodiments of the invention which incorporate such recited elements have been illustrated in the drawings. Referring to the "Guidelines for the Examination of Patent Applications..." presented in Section 2163 of the Manual of Patent Examining Procedure, "A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claim and determined that the invention would work for its intended purpose", citing Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998). This has been done in the present case.

In view of the foregoing, it is respectfully submitted that claims 22 and 31, which are currently replaced by claims 38 and 33, respectively, are in full compliance with the written description requirement of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of this formulated rejection is, therefore, respectfully requested.

The Office Action of April 28, 2009, next rejects claims 14 to 31 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement, and under 35 U.S.C. §112, second paragraph, as being indefinite for corresponding reasons. Such rejections are also respectfully traversed in view of the discussion which follows.

In formulating these rejections, the statement is first made that "[r]egarding claim 14, it is not clear how the rotational movement of the adjustment ring causes a translational movement of the fixed thimble support" (emphasis supplied in the original text). Firstly, the intended meaning of this statement is not understood because a "fixed thimble support" is neither recited in rejected claim 14 nor in the claim which currently replaces it (claim 32). Secondly, an enabling description of "how the rotational movement of the adjustment ring causes a translational movement of the... thimble support" was provided by the original specification and drawings.

As is correctly noted in the Office Action, "[t]he specification of the claimed invention discloses on page 4, paragraph 3 [of the substitute specification], that the thimble support is held in the attachment ring 11 without rotation...", which corresponds to lines 26 to 32 of page 3 of the original specification. However, noting lines 27 and 28 of page 2, the original specification further indicated that:

On the inside of the adjustment ring 3 is a screw thread 14 by which it is fixed to the thimble support 4.

Lines 14 to 23 of page 3 further indicated that:

On the outside of the thimble support 4 is a screw thread 17 allowing it to be engaged with the adjustment ring 3....

On the underside of the thimble support 4 are screw columns 18, enabling the thimble 6 to be held non-rotatably in the attachment ring 11, creating a sliding connection. (emphasis added)

Lines 20 and 21 of page 4 further indicated that:

Turning the adjustment ring 3 therefore results in a vertical movement of the thimble support
4. (emphasis added)

Lines 5 to 8 of page 5 further indicated that:

The mill adjustment device according to the invention modifies the position between the wheel and the thimble by moving the thimble, not by moving the wheel as is the usual practice. (emphasis added)

Consequently, it is clear that vertical movements of the thimble support are possible, and that the claims contain subject matter which was described in the specification "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the [invention]".

In addition, an amendment has been made to the paragraph connecting pages 5 and 6 of the substitute specification submitted with the Reply which was filed in this matter on January 12, 2009, to indicate that "[t]urning the adjustment ring 3 results in vertical sliding movement of the thimble support 4" to better correlate this disclosure with the disclosure which was provided in the original specification for this Patent Application at page 3, lines 20 to 23.

The statement is next made that "the disclosed specification does not clearly describe how the reinforcement cooperates with the adjustment stop to limit movement of the adjustment ring [and] does not describe how the reinforcement

cooperates with [the] adjustment stop". However, lines 3 to 8 of page 3 of the original specification indicated that:

The thimble support 4 is provided with a reinforcement 15 which makes contact with the adjustment stop 5 of the adjustment ring 3 at the forward and reverse limits. It is level with the notches 16 which take the indexing bar 12 on the outer top face of the thimble support 4. (emphasis added)

Such disclosure, in combination with the corresponding structures which are best illustrated with reference to Figure 1 of the drawings, makes it clear that as has already been noted in the Office Action, "the adjustment stop slides along the outer upper surface of the thimble support until an outer edge portion of the stop abuts an outer edge portion of the reinforcement in order to cause limit (sic) movement of the adjustment ring".

Consequently, it is once again clear that the claims contain subject matter which was described in the specification "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the [invention]".

It is, therefore, respectfully submitted that claims 14 to 31, which are currently replaced by claims 32 to 49, are in full compliance with the enablement requirement of 35 U.S.C. §112, first paragraph. In view of the foregoing explanations, it is further respectfully submitted that pending claims 32 to 49, which replace claims 14 to 31, are sufficiently defined for "particularly pointing out and distinctly claiming the subject

matter which the applicant regards as his invention", in full compliance with the requirements of 35 U.S.C. §112, second paragraph, as well. Reconsideration and withdrawal of the foregoing rejections of claims is, therefore, respectfully requested.

As a final matter, it has been noted that the Office Action of April 28, 2009, rejects claims 14 to 31 "as best as understood" under 35 U.S.C. §102(b) as being anticipated by Kraus (U.S. Patent No. 3,124,313). It is submitted that with a fuller understanding of the claims, resulting from the foregoing discussion, it is apparent that Kraus has no relevance to the subject matter of former claims 14 to 31 in that the above discussed structural elements are not present in Kraus, and in that Kraus fails to disclose any of the structural interactions of such elements which were recited in former claims 14 to 31.

Moreover, the rejection of applicant's claims 14 to 31 is left moot by the replacement of such claims by newly presented claims 32 to 49. Independent claim 32 is directed to a device for adjusting the grinding of a condiment in a mill. To this end, a grinder is provided which includes a thimble coupled with a thimble support (see page 3, lines 1 and 2, of the original disclosure) and a wheel coupled with the thimble for grinding the condiment responsive to relative rotation between the wheel and the thimble (see page 4, lines 1 to 8, of the original disclosure). An adjustment ring is coupled with the grinder

and includes an adjustment stop (see page 2, lines 14 to 17, of the original disclosure). Rotational movement of the adjustment ring causes vertical movement of the thimble support within the mill (see page 4, lines 20 and 21, of the original disclosure). The wheel is vertically fixed in position within the mill (see page 4, lines 25 and 26, of the original disclosure), and rotational movement of the adjustment ring causes vertical movement of the thimble relative to the vertically fixed wheel (see page 5, lines 5 to 8, of the original disclosure). Other distinguishing features are recited in dependent claims 33 to 49 and a reconsideration of all of the claims which are currently presented in this Patent Application is respectfully requested.

From this, it will be apparent that Kraus has no relevance to the subject matter of newly presented claims 32 to 49 in that the recited structural elements are not present in Kraus, and in that Kraus fails to disclose any of the structural interactions of such elements which are recited in claims 32 to 49. It is, therefore, submitted that applicant's newly presented claims 32 to 49 are not subject to rejection under 35 U.S.C. §102(b) as being anticipated by the disclosure of Kraus, and that applicant's claims are in condition for allowance, as currently presented.

Entry of the present Amendment, and a favorable consideration of this Patent Application in view of the foregoing, is respectfully requested.

Respectfully submitted,



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